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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,036	04/24/2006	Kazunori Yamazaki	053466-0447	9627
23428 7590 08/11/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
HOLLOMAN, NANETTE				
ART UNIT		PAPER NUMBER		
1612				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,036

**Applicant(s)**

YAMAZAKI ET AL.

**Examiner**

NANNETTE HOLLOMAN

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is in response to the Request for Continued Examination filed on April 21, 2009. Applicants' arguments, filed April 21, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 103 (Previous Rejections)***

1) Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1). This rejection is maintained and further applied to new claims 6 and 7.

#### **Applicant's Arguments**

Applicant argues Mitsumatsu discloses pentaerythritol ester oil having a formula similar to those of the compounds used in Examples 1 and 2 and comparative example 1 and merely having pentaerythritol ester derived oil ingredients is insufficient to achieve desirable unexpected properties. Applicant further argues the desired results can be

obtained only when the pentaerythritol ester has two or three benzoic acid residues, as recited in instant claim 1. This argument is not found persuasive.

Examiner's Response

In regards to the pentaerythritol ester oil, on page 27-28 the disclosed formula and R groups of Mitsumatsu et al. would reasonably lead one skilled in the art to the claimed composition because the R groups are encompassed by the instant claims, which includes the use of tri- and bi- benzoic acid. In regard to Applicant's alleged unexpected results, it appears the results are for lipstick compositions only and the scope of the rejected claims encompass more than lipstick. Specifically, claim 1 recites the limitation of the genus of a cosmetic composition. Furthermore, the results are based on opinion, as shown by the evaluation criteria as disclosed in the instant specification at p. 7, lines 15-18; wherein a "B" is 6 or more out of 10 but less than 8 judged good and "C" is 4 or more out of 10 but less than 6 judged good, and proper analysis cannot be done on opinion. In addition, in comparing Ex. 1 and Comp Ex. 2, it appears Applicant's conclusion of superior results is based on a difference of 1 person in the comparison of gloss on lips, moisture feeling and cosmetic durability, and consequently does not appear to support superior results, since there appears to be no way to quantify Applicant's results or to know what constitutes error in the results. The results do not appear to be unexpected, but purely *arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of

pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

2) Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1) as applied to claims 1-3 above, and further in view of Healy et al. (WO 00/26285). This rejection is maintained.

#### Applicant's Arguments

See Applicant's argument and Examiner's response above in regards to Mitsumatsu et al. In regards to Healy et al., Applicant argues there is no motivation to combine Mitsumatsu and Healy and neither teach or suggest a composition as presently claimed, particularly with respect to the structure comprising two or more benzoic acid residues. Applicant further argues the teaching of Mitsumatsu and Healy, alone or in combination cannot provide the unexpectedly desirable results provided by the presently claimed compositions. This argument is not found persuasive.

#### Examiner's Response

Healy et al. as previously disclosed teach compounds that are structural homologs of the instantly claimed compounds, i.e. they differ only by CH<sub>2</sub> groups, and also disclose use as a lipstick. Therefore, one of ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held

that compounds that are structurally homologous to prior art compounds are *prima facie* obvious, absent showing of unexpected results. See MPEP 2144.09.

In regards to Applicant's asserted unexpected desired results of Table I and claim 5, it is reasonable to conclude that similar results, such as improve gloss of lips after application of the composition to the lips, would occur when using the composition of Mitsumatsu et al. in view of Healy et al. because the combined teaching suggest the compositions of the instant claims.

Furthermore, the results are based on opinion, as shown by the evaluation criteria as disclosed in the instant specification at p. 7, lines 15-18; wherein a "B" is 6 or more out of 10 but less than 8 judged good and "C" is 4 or more out of 10 but less than 6 judged good, and proper analysis cannot be done on opinion. In addition, in comparing Ex. 1 and Comp Ex. 2, it appears Applicant's conclusion of superior results is based on a difference of 1 person in the comparison of gloss on lips, moisture feeling and cosmetic durability, and consequently does not appear to support superior results, since there appears to be no way to quantify Applicant's results or to know what constitutes error in the results. The results do not appear to be unexpected, but purely *arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

***Declaration***

The Declaration under 37 CFR 1.132 filed May 19, 2009 is insufficient to overcome the rejections of claims 1-7 based upon Mitsumatsu and Mitsumatsu in view of Healy applied under 35 U.S.C. 103 as set forth in the last Office action because: it is reasonable to conclude that similar results, such as improved gloss of lips after application of the composition to the lips, would occur when using the composition of Mitsumatsu et al. in view of Healy et al. because the combined teaching suggest the compositions of the instant claims.

Applicant's declaration conclude to show the superiority of the use of dibenzoic acid-2-ethylhexonic acid behenic acid pentaerythritol ester, which R1 is a 2-ethylhexanoic acid residue and R2 is a behenic acid residue in the formula (I) in the claim 1.

Furthermore, the results are based on opinion, as shown by the evaluation criteria as disclosed in the instant specification at p. 7, lines 15-18; wherein a "B" is 6 or more out of 10 but less than 8 judged good and "C" is 4 or more out of 10 but less than 6 judged good, and proper analysis cannot be done on opinion. In addition, in comparing Ex. 1 and Comp Ex. 2, it appears Applicant's conclusion of superior results is based on a difference of 1 person in the comparison of gloss on lips, moisture feeling and cosmetic durability, and consequently does not appear to support superior results, since there appears to be no way to quantify Applicant's results or to know what constitutes error in the results. The results do not appear to be unexpected, but purely

*arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612